

## REMARKS

### I. Introduction

This amendment is responsive to the Office Action mailed October 16, 2007, and the Advisory Action mailed February 29, 2008. Claims 1-10 and 12-35 are pending in the application and currently stand rejected. As indicated in the Office Action, applicants' prior arguments were considered and found persuasive, but were moot in view of newly stated grounds of rejection.

The Office Action rejected Claims 1, 2, 4-10, and 12-35 under 35 U.S.C. §103(a) as being allegedly unpatentable over Siegel et al., U.S. Patent Application Publication No. 2002/0082931 (hereinafter "Siegel"), in view of Kinjo, U.S. Patent Application Publication No. 2003/0063575 (hereinafter "Kinjo"). Claim 3 was rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over Siegel and Kinjo, and further in view of Fitzsimmons, Jr., U.S. Patent Application Publication No. 2002/0068991 (hereinafter "Fitzsimmons"). The Advisory Action maintained the claim rejections as set forth in the Office Action.

Applicants have carefully considered the cited references as well as the comments provided in the Office Action and the Advisory Action. Reconsideration of the application is requested. Claims 1, 12, 13, 22, 30, and 34 have been amended. The amendments to the claims are supported by the specification as originally filed at least at page 4, line 29, to page 5, line 10, and page 3, lines 17-20.

Applicants submit that the cited references do not support a *prima facie* rejection of the claims under 35 U.S.C. §103(a). For a *prima facie* case of obviousness under Section 103, the cited references (alone or in combination) must teach all of the elements set forth in the claims. *In re Bell*, 991 F.2d 781 (Fed. Cir. 1993). Applicants submit that the cited and applied references, alone or in combination, fail to disclose or suggest all of the elements recited in the claims and indeed teach away from the present application. The claims should thus be allowed.

## II. Interview Summary

Prior to addressing the patentability of the claims, the undersigned counsel thanks Examiner Serrao for the time he extended in a telephone interview conducted on February 19, 2008. The interview was conducted in light of the Office Action noted above and applicants' Response to Final Office Action submitted December 21, 2007. The discussion in the interview was directed to the distinction between Claim 1 and the prior art, particularly the recitation of a "second retail entity" from which the selected item is available for purchase and which receives an image directly from an imaging device of the user while the user remains present at the location of the first retail entity, processes the image, and responds directly to the imaging device of the user. The interview concluded with applicants' agreement to submit the present amendment for further consideration.

## III. Claim Rejections Under 35 U.S.C. §103(a)

### A. Independent Claim 1

Claim 1 is directed to a method for a second retail entity to communicate information regarding a selected item to a user present at the location of a first retail entity, which second retail entity is different from the first retail entity. As recited in Claim 1, while the user remains present at the location of the first retail entity, "the second retail entity: receiv[es] an image directly from an imaging device of the user, wherein the image contains identifying data associated with the selected item." The method of Claim 1 further requires the second retail entity to "extract[] the identifying information from the image" and "us[e] the identifying data to obtain item information associated with the selected item, wherein the selected item is available for purchase from the second retail entity." The second retail entity thereafter "communicat[es] the item information directly from the second retail entity to the imaging device of the user."

These elements in combination are not taught or suggested by Siegel and Kinjo.

### **Siegel and Kinjo Fail to Teach "Second Retail Entity"**

Claim 1 is patentably distinct from the cited art for at least the reason that Siegel and Kinjo fail to teach a "*second retail entity: receiving an image directly from an imaging device of the user . . . ; extracting the identifying data from the image; using the identifying data to obtain item information associated with the selected item . . . ; and communicating the item information directly . . . to the imaging device of the user,*" and from which second retail entity "the selected item is available for purchase," as recited in Claim 1.

As previously noted in applicants' December 21, 2007, response, the electronic retail network server 104 described by Siegel uses machine-readable UPC code information to obtain pricing information that is available from participating stores and vendors. See, for example, paragraph [0014] of Siegel:

According to one other aspect, location-determining technology is added to the bar code scanning and information retrieval system. The combination of bar code and geographic coordinates can be used to provide location specific information to a consumer. Thus, the present invention enables a user to readily obtain information associated with the vendor *at the location where the product is scanned* (if, for example, this location is a retail establishment) *and other vendors of the scanned product in the vicinity* (e.g., within a number of miles selected by the user) of the scanning device or at any other location of interest. Information can be provided to the user concerning nearby vendor location, maps to these vendors and product pricing and availability at these vendors, for example.

The Advisory Action expressly acknowledged that Siegel's electronic retail network server 104 does not constitute the "second retail entity" recited in Claim 1. Instead, the Advisory Action pointed to "various online retailers" as referenced by Siegel at paragraph [0066]. This paragraph describes an extension of a customer "wish list" to grocery shopping and explains as follows:

This concept can be extended to include grocery shopping. By scanning the UPCs on various grocery goods, the customer can create a list of frequently purchased groceries. The electronic retail network can transfer the various UPC codes to various online retailers, for example, for comparison-shopping, and the customer can subsequently purchase the

items over the Internet if desired. The electronic retail network can also provide the customer with additional information relating to the scanned groceries, for example, nutritional information or recipes containing the scanned groceries.

In the Advisory Action, the Examiner alleged that the "various online retailers" constitute the claimed "second retail entity," but applicants submit that cannot be the case. According to Claim 1, as amended, the second retail entity is "receiving an image directly from an imaging device of the user . . . and communicating the item information directly . . . to the imaging device of the user." None of the various online retailers according to Siegel receive an image directly from an imaging device of the user, nor do the online retailers communicate item information directly to the imaging device of the user. Instead, it is a separate electronic retail network server<sup>104</sup> that receives the scanned UPC information from the user and communicates information to the user. The electronic retail network server<sup>104</sup> of Siegel is not operated by the various online retailers, nor is it suggested that any one of the online retailers may operate the electronic retail network server<sup>104</sup>. Rather, the electronic retail network server<sup>104</sup> is a separate, external entity that allegedly can interact as an intermediary with the various online retailers. In paragraph [0071], Siegel explains:

As an example, a customer can scan a UPC symbol 100 of a stereo component at participating Store A using a scanning device 101 associated with an Internet-ready device 102. The device 102 can then contact an electronic retail network server 104 over the Internet and transmit information concerning the UPC code as well as information regarding the global position of the Internet-ready device 102. Using this information, the electronic retail network server 104 can then supply information to the Internet-ready device 102 regarding pricing available at store A, as well as the nearby participating vendors (Store B, Store C, etc.).

As illustrated above, the electronic retail network server<sup>104</sup> is not operated by the store where the user is located (Store A) nor is it operated by the nearby participating vendors (Store B, Store C, etc.). Furthermore, as per Siegel, it is the electronic retail network server 104 that supplies information to the Internet-ready device of the user, not any of the Stores A, B, C, etc.

In contrast, in Claim 1, it is *the second retail entity* that "communicat[es] the item information directly . . . to the imaging device of the user."

The Examiner has already correctly acknowledged that the electronic retail network server 104 of Siegel is not the second retail entity claimed in Claim 1. See Advisory Action, page 2. Applicants request that the Examiner also acknowledge that the various online retailers (e.g., Stores A, B, C above) taught by Siegel do not meet the requirements of the second retail entity as claimed in Claim 1.

As for Kinjo, the Office Action and Advisory Action do not allege nor can applicants find any disclosure that could be combined with Siegel to transform Siegel's various online retailers into the "second retail entity" as claimed, especially a second retail entity that "receiv[es] an image directly from an imaging device of the user [while the user remains present at the location of the first retail entity] . . . and communicat[es] the item information directly from the second retail entity to the imaging device of the user," as claimed.

Simply stated, neither Siegel nor Kinjo (alone or in combination) teaches or suggests all of the combination of features recited in independent Claim 1. Accordingly, for at least the reasons set forth above, applicants submit that Claim 1 is patentable over Siegel and Kinjo. Withdrawal of the rejection of Claim 1 is respectfully requested.

B. Dependent Claims 2 and 4-10

As discussed above, Siegel and Kinjo fail to teach all of the combination of features of independent Claim 1. Where dependent Claims 2 and 4-10 ultimately depend from independent Claim 1, Claims 2 and 4-10 are likewise allowable over Siegel and Kinjo for at least the reasons discussed above in connection with Claim 1. Claims 2 and 4-10 are also allowable for the additional subject matter they recite.

C. Dependent Claim 3

As with Claims 2 and 4-10, applicants submit that Claim 3 is patentable over Siegel and Kinjo because of the failure of the references to teach all of the features of independent Claim 1.

Additionally, applicants have considered the disclosure of Fitzsimmons with respect to Claim 3, as well as all other pending claims in the present application, and submit that Fitzsimmons does not overcome the deficiencies of disclosure in Siegel and Kinjo as discussed herein.

D. Independent Claim 12

Claims 12 and 15-28 were rejected under the same basic rationale as Claims 1, 2, and 4-10. Claim 12 has been clarified to state that the subsystem is configured "to receive an image directly from the imaging device of the user, wherein the image contains identifying data associated with the selected item . . . [and] to communicate the item information directly to the imaging device of the user while the user remains present at the location of the first retail entity."

For reasons similar to those discussed above with respect to Claim 1, applicants respectfully submit that Siegel and Kinjo fail to teach all of the combination of elements recited in Claim 12, and especially fail to teach "*a server operated by a second retail entity*" having one or more subsystems configured to perform the tasks recited in Claim 12. Accordingly, Claim 12 is patentable over Siegel and Kinjo. Withdrawal of the rejection of Claim 12 is requested.

E. Dependent Claims 13-21

Dependent Claims 13-21 ultimately depend from independent Claim 12. As discussed above, applicants submit there is no combination of Siegel and Kinjo that teaches or suggests all of the elements of independent Claim 12. Claims 13-21 also include a number of recitations not disclosed, taught, or suggested by Siegel or Kinjo, particularly when the recitations are considered in combination with the recitations of Claim 12 from which these claims depend. For the above-mentioned reasons, Claims 13-21 are likewise allowable. Withdrawal of the rejections under Section 103 is requested.

F. Independent Claim 22

Amended Claim 22 recites elements similar to those of amended Claim 1. Accordingly, based on the above analysis of Claim 1, applicants similarly submit that Siegel and Kinjo, whether considered alone or combined, fail to teach or suggest all of the elements of Claim 22.

In particular, Siegel and Kinjo fail to teach the recited "computer-executable component [that] is executed by a server of the second retail entity" that "receiv[es] an image directly from an imaging device of the user" and "communicat[es] the item information directly from the server to the imaging device of the user while the user remains present at the location of the first retail entity." For at least these reasons, the rejection of Claim22 should be withdrawn.

G. Dependent Claims 23-29

Claims23-29 are dependent on Claim22 and, thus, are allowable for the reasons discussed above in connection with Claim22. Claims23-29 also include a number of recitations not disclosed, taught, or suggested by Siegel or Kinjo, particularly when the recitations are considered in combination with the recitations of Claim22 from which these claims depend. For these reasons, Claims23-29 are patentable over Siegel and Kinjo.

H. Independent Claim 30

Claim30 is directed to an "integrated portable apparatus for obtaining item information for a selected item available for purchase at a location of a first retail entity." The apparatus comprises, among other things, "a processing unit communicatively coupled to the input device, the output device, and the storage medium, for executing the program instructions that process the image by: obtaining the item information for the selected item by communicating the image containing the identifying data directly to a server operated by the second retail entity, wherein the selected item is available for purchase from the second retail entity; and outputting on the output device the item information obtained directly from the server of the second retail entity, wherein the output device communicates the item information to a user while the user remains at the location of the first retail entity."

For reasons similar to those previously discussed with respect to Claim1, neither Siegel nor Kinjo discloses directly communicating the image containing the identifying data to a server operated by the second retail entity, wherein the selected item is available for purchase from the second retail entity. Although Siegel allegedly teaches that a consumer can scan a UPC code

using a scanning device so that an electronic retail network server 104 can receive or download information concerning the item identified by the UPC code, Siegel does not teach that an image containing the identifying data is communicated "directly to a server operated by the second retail entity" at which "the selected item is available for purchase." Furthermore, Siegel does not teach an apparatus that outputs "item information obtained directly from the server of the second retail entity," as claimed.

Kinjo, for its part, does not cure the deficiencies of disclosure in Siegel. To the extent Kinjo discloses communicating an image, it does not do so to a server operated by *a second retail entity* as claimed. These aspects of Siegel and Kinjo, even if combined, do not render obvious the apparatus claimed in Claim30 in which the image containing the identifying data is communicated directly to a server operated by the second retail entity from which the selected item is available for purchase and from which item information is obtained directly for output to the user.

For at least the above reasons, as well as the reasons presented with respect to Claim1, applicants submit that Claim30 is patentable over the cited art.

I. Dependent Claims 31-35

Dependent Claims31-35 depend from independent Claim30. As discussed above, both Siegel and Kinjo fail to teach each of the elements of independent Claim30. Accordingly, Claims31-35 are likewise patentable over the cited art.



### CONCLUSION

In view of the foregoing remarks, applicants submit that all of the pending claims in the application are in condition for allowance. Reconsideration of the application and allowance of the claims is solicited. If the Examiner has any remaining questions or comments concerning this matter, the Examiner is invited to contact the undersigned attorney at the number provided below.

Respectfully submitted,

CHRISTENSEN O'CONNOR  
JOHNSON KINDNESS<sup>PLLC</sup>



Kevan L. Morgan  
Registration No. 42,015  
Direct Dial No. 206.695.1712